

Art Unit: 2426

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/08/2011 has been entered.

DETAILED ACTION

Status of Claims

2. Claims 1-26, 31-58 and 60-66 are pending in this application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 57 and 58 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claims 57 and 58, the claims are set forth a "computer readable medium." However, the specification as originally filed does not explicitly define the computer readable medium. The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable media (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and

Art Unit: 2426

transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is absent an explicit definition or is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2. This rejection may be overcome by amending the claim to read a "non-transitory" computer readable medium.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-23, 26, 31-58 and 62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) in view of Ellis et al (US 2008/0184315).

Regarding Claims 1, 20, 39, 57 and 58, Schein discloses a system (FIG.1, FIG.16A) with corresponding method and a computer readable medium (FIG.1, 18) having stored thereon a set of instructions for displaying an advertisement (FIG.16A, 524, 526, 528), when executed by a microprocessor (FIG.1, 16), cause the microprocessor to perform the step of:

storing, local to a user equipment, viewer profile information in a first database (refer but not limited to Para 109; viewing history);

receiving advertisement information and stored in second database; the advertisement including primary advertisement information; a processor configured to retrieve the stored

Art Unit: 2426

advertisement from the second database and display the advertisement (refer but not limited to Para 7 lines 1-5; Para 50; such as a broadcast commercial).

Schein is silent about selecting a supplemental advertisement information item from a plurality of advertisement information items based on the received advertisement and the stored viewer profile information; overlaying, local to the user equipment, the selected supplemental advertisement information item onto the received advertisement to form a customized advertisement; and a display screen configured to display the customized advertisement, wherein the displayed customized advertisement includes both the primary and the overlaid selected supplemental advertisement information item.

In an analogous art, Ellis discloses in a preferred embodiment, the currently-tuned television signal comprises a commercial advertisement and the product or service available is associated with the commercial... For example, in the simplest embodiment, only a single product, i.e., a product brochure, may be available. In this case, the microcontroller 16 may be configured to cause the video overlay device 25 to display a standard on-screen message such as "Press * to receive a brochure describing this product." This embodiment assumes that the user has previously provided his name and address or that the information is extracted from the program services billing system (refer but not limited to Para 230).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein's system to include a selected supplemental advertisement information item related to a promotion item, such as a product or service, as taught by Ellis, to take advantage of targeting the specific viewers with corresponding item; thereby improve advertising effectiveness.

Alternatively, Ellis further discloses this embodiment is especially useful in connection with commercial advertisements and permits the user to place an order for the product or service being advertised using the remote control device 40 (Para 228).

Therefore, a person of ordinary skill in the art would have had good reason to pursue the known options to permit the user to place an order for the product or service being advertised as

Art Unit: 2426

a popular alternative for promotion. It would require no more than "ordinary skill and common sense" to take advantage of the opportunity to create more revenues as a result.

Regarding Claim 2, Schein in view of Ellis disclose the receiving, selecting, customizing, and displaying steps are performed in substantially real time (Para 230; customize the broadcast commercial is substantially real time).

Regarding Claims 3, 13, 14 and 49-50, Schein further discloses promotional information about a future TV program or product is a video preview (Para 129; Para 133 lines 21-23).

Regarding Claims 4, 5 and 40-42, Schein further discloses promotional info about a currently telecast and future TV program, and products and service (Para 129, Para 133 lines 21-25).

Regarding Claims 6 and 43, Schein discloses storing favor program guide information and respective advertisements for display. Therefore, Schein inherently discloses combining a portion of the received advertisement with stored favor channel information (FIG.16A, 524, 528; Para 109-111; as the favor program guide including the corresponding favorite channels and programs such as a guide shown in FIG.16A).

Regarding Claims 7 and 44, Schein further discloses storing a favor program information and combining a portion of the received advertisement with stored favor program information (FIG.16A, 524, 528; Para 109-111, especially Para 109 lines 1-7; user is able to customize a favorite program list with advertisement such as a guide shown in FIG.16A).

Regarding Claims 8, 16, 45 and 52, Schein further discloses storing a web site address and combining a portion of the received advertisement with stored a web site address and

Art Unit: 2426

activating a function comprising linking to a web site based on an address related to the selected info and displaying more info from the web sites (Para 139 lines 1-11, Para 144 lines 8-12).

Regarding Claims 9 and 46, Schein is not clear about storing information related to a geographical location and may be used to combine a portion of the received advertisement with the info related to a geographical location.

In an analogous art, Ellis discloses storing an info related to a geographical location and may be used to combine a portion of the received advertisement with the info related to a geographical location (Para 230, a viewer's address).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein's system to include advertisement with the info related to a geographical location, as taught by Ellis to target individual viewers.

Regarding Claims 10 and 47, Schein further discloses storing info related to a TV viewer and combining a portion of the received advertisement with the info related to a TV viewer (Para 128).

Regarding Claims 11, 12 and 48, Schein also discloses the 1st database includes info related to rotating ad info in the EPG for combining a portion of ad data with the stored info related to rotating ad info and further display the advertisement info in the EPG based on the rotating advertisement info (FIG.16A, Para 134 lines 4-9).

Regarding Claims 15, 17, 51 and 53, Schein further discloses steps of selecting the displayed info using a pointing device and activating a function related to the selected info and display more detail info related to the selected info and selected advertisement (FIG.1, 40; Para 95; Para 133).

Art Unit: 2426

Regarding Claims 18, 19 and 54, Schein further discloses step of activating a function comprising scheduling future and currently telecast TV program for recording (FIG.11, 230; FIG.18A; FIG.19A; Para 96).

Regarding Claims 21-23, Schein further discloses promotional info about a currently telecast and future TV program, and products and service (Para 129; Para 133 lines 21-25).

Regarding Claims 26 and 34, Schein is not clear about overlaying an icon to access the products from a website for more information.

In an analogous art, Ellis teaches overlaying an icon to access the products for more information (Para 230); furthermore using an icon to link to a website to get more information such as product is well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to a link to a web site, to take advantage of internet technology to access more information.

Regarding Claims 31 and 32, Schein further discloses promotional information about a future TV program or product is a video preview (Para 129; Para 133 lines 21-23).

Regarding Claim 33, Schein further discloses the steps of selecting the displayed advertisement using a pointing device and activating a function related to the selected advertisement (FIG.1, 40).

Regarding Claim 35, Schein further discloses the steps of activating a function comprising more detail info related to the selected advertisement (Para 127 lines 1-6).

Art Unit: 2426

Regarding Claim 36, Schein further discloses the steps of activating a function comprising displaying a video preview related to the selected advertisement (Para133 lines 21-26).

Regarding Claim 37, Schein further discloses step of activating a function comprising scheduling future and currently telecast TV program for recording (Para 96).

Regarding Claim 38, Schein further discloses the steps of activating a function comprising tuning to a currently telecast television program (Para 96).

Regarding Claim 55, Schein further discloses the steps of activating a function comprising tuning to a currently telecast television program (Para 96).

Regarding Claim 56, Schein further discloses promotional information about a future TV program or product is a video preview (Para 129, Para 133 lines 21-23).

Regarding Claims 62, Schein further discloses the customized advertisement is displayed on a first portion of the display (FIG.16A, 524, 526 or 528 for customized advertisement) and television schedule information is displayed on a second, non-overlapping, portion of the display (FIG.16A, 508; program matrix of cells including program schedule information).

Regarding Claims 63, Schein further discloses the customized advertisement is displayed on a first portion of the display (FIG.16A, 524, 526 or 528 for customized advertisement) and a video is displayed on a second, non-overlapping, portion of the display (FIG.16A, 526; to display the selected program).

Art Unit: 2426

Regarding Claims 64, Schein is not clear about displaying the primary advertisement information in one portion and the supplemental information in another portion.

In an analogous art, Ellis discloses, in one embodiment, the primary advertisement information is displayed on a first portion of the display (FIG.9, HBO program Shaker Run), and the supplemental advertisement information is displayed on a second, non-overlapping, portion of the display (FIG.9, HBO order message).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display the primary advertisement information in one portion and the supplemental information in another portion as an engineering choice.

Regarding Claims 65, Schein is not clear about the primary advertisement information is displayed on a first portion of the display, and the supplemental advertisement information item is displayed on a second portion of the display; wherein the second portion of the display overlaps at least partially with the first portion of the display

In an analogous art, Ellis discloses the primary advertisement information is displayed on a first portion of the display, and the supplemental advertisement information is displayed on a second portion of the display; wherein the second portion of the display overlaps at least partially with the first portion of the display (Para 230; the supplemental advertisement information in one portion of the display overlays the primary advertisement in another portion of the display).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to overlay the supplemental advertisement information over the primary advertisement information as an engineering choice.

5. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) and Ellis et al (US 2008/0184315) as applied to claim 20 above, and further in view of Coleman et al (US 5,844,620).

Art Unit: 2426

Regarding Claims 24 and 25, Schein discloses storing and displaying a favor program listing but is silent about overlaying the stored favor channel/program information onto a portion of the stored advertisement information.

In an analogous art, Coleman discloses overlaying the stored program guide information onto a portion of a programming which could be an advertisement to search for new channels or programs (FIG.6; Col 5 lines 22-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Schein and Ellis to include overlaying the stored favor channel/program listing onto a portion of the stored advertisement information, without interruption of existing programming while look for favor new channels/programs.

6. Claims 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) and Ellis et al (US 2008/0184315) as applied to claim 1 above, and further in view of Esch et al (US 5,099,319).

Regarding Claim 60, Esch discloses allowing customized television commercials by adding text in any language (Col 3 lines 45-51). Therefore, a person of ordinary skill in the art would have had good reason to pursue the known options to replace the original text with customized text to target the certain group. It would require no more than "ordinary skill and common sense," to replace the original text with customized text to achieve targeting purpose.

Regarding Claim 61, Esch also discloses adding graphics to customize a commercial (Col 3 lines 45-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace a graphical portion of the received advertisement information with a graphic portion of the supplemental advertisement information to take advantage of graphical form to customize an advertisement for targeted group as an engineering choice or known options to try as common sense.

Art Unit: 2426

7. Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) and Ellis et al (US 2008/0184315) as applied to claim 1 above, and further in view of Narasimhan et al (US 6,237,145).

Regarding Claim 66, Ellis discloses an option of permitting a user to place an order for the product or service being advertised (Para 228), but is not explicit about selection of the order option is based on the user profile.

In an analogous art, Narasimhan discloses using a user profile to guide the user in accessing promotions. For example, a user that accesses a number of promotions for a certain type of automobile may be presumed to be interested in purchasing such type of automobile (Para 202).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a supplemental advertisement information item based on the user profile to take advantage of the well-known targeting technique to achieve advertising effectiveness.

Response to Arguments

8. Applicant's arguments with respect to claims 1-26, 31-58 and 60-66 have been considered but are moot in view of the new ground(s) of rejection.

In reference to Applicant's arguments

Thus, a selection of Ellis's message represents, at most, a selection from one possible advertisement information item. Further, Ellis's message is described as being a "standard on-screen message" (Ellis, paragraph 230) and disclosure cannot be found in the cited portions of Ellis for including more than one version of Ellis's message with a particular advertisement. The cited portions of Ellis therefore describe selecting a supplemental advertisement information item

Art Unit: 2426

from, at most, one possible advertisement information item for display with a particular advertisement based on viewer profile information.

Examiner's response

Please refer to the grounds of rejections as shown in claims 1, 20, 39, 57 and 58 for these arguments.

Conclusion

9. Claims 1-26, 31-58 and 60-66 are rejected.

Correspondence Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRED PENG whose telephone number is (571)270-1147. The examiner can normally be reached on Monday-Friday 09:30-19:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hirl can be reached on (571) 272-3685. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fred Peng/

Examiner, Art Unit 2426